

Application No.: 09/825,741
Filing Date: April 3, 2001

REMARKS

In response to the Office Action mailed September 25, 2007, Applicants respectfully request that the Examiner reconsider the above-captioned patent application in view of the foregoing amendments and the following comments. Claims 1-7, 16, 21, 50-53, 70-72 and 75-94 remain pending. Claims 1, 3, 4, 7, 16, 21, 71, 72 are amended, new Claims 75-94 are added, and Claims 8-15, 17-20, and 22-49 (which includes the previously withdrawn claims) are cancelled. No new matter has been added.

The Examiner's position in the Office Action mailed September 25, 2007 is summarized as follows:

CLAIM NOS.	DISPOSITION/REJECTION		
	BASIS	PRIMARY REFERENCE	SECONDARY REFERENCE(S)
1-11, 16-22, 35-38, 40, 41, 50-53 and 70-72	102(e)	Navarro et al., U.S. No. 6,398,777	n/a
12-15, 39	103(a)	Navarro et al., U.S. No. 6,398,777	Makower et al., U.S. No. 6,190,353

Navarro – Claim 1

Claim 1 was rejected by the Examiner as anticipated by Navarro. Applicants respectfully traverse the rejection. The amendments to Claim 1 were made solely to expedite prosecution. Navarro does not teach or suggest all of the limitations of Claim 1. For example, Navarro does not teach or suggest introducing a treatment device into a hollow anatomical structure where the treatment device comprises “an elongate shaft and an electrically driven energy application device at a working end of the shaft.” (See Claim 1). In contrast, Navarro teaches only the use of laser energy to treat varicose veins. The objects of Navarro “are achieved by a method for treating varicose veins using a tipped laser energy carrier to deliver laser energy into the blood vessel lumen to produce direct endothelial and vein wall damage and subsequent fibrosis.” (Navarro Col. 3:13-18).

Not only does Navarro lack a teaching of the referenced claim limitations, Navarro actually criticizes other modes of treatment. In particular, Navarro teaches away from use of electricity to treat varicose veins, stating that “use of electricity invariably leads to coagulation of blood with the blood vessel, rather than causing fibrosis of the blood vessel itself.” (Navarro

Col. 2:1-6). This disparagement of the use of electricity demonstrates not only that Navarro does not anticipate Claim 1, but also that it would be improper to combine Navarro in an obviousness rejection. The MPEP states: "It is improper to combine references where the references teach away from their combination." M.P.E.P. § 2145(X)D2, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Moreover, "in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)"; M.P.E.P. § 2141.02(I). Navarro teaches the use of lasers to treat varicose veins, which is a competing technology to the use of electricity to treat hollow anatomical structures. Thus, taking the "claimed invention as a whole" it would not have been obvious to use one aspect of one technology (e.g., a fiber optic device) with other aspects of competing technologies (e.g., the electrically driven energy application device of Claim 1). This is especially true in light of Navarro's teaching away cited above.

For these reasons, it is respectfully requested that the rejection be withdrawn.

Navarro – New Claims 78 and 89

Navarro does not anticipate new independent Claim 78 for similar reasons to those discussed in regard to Claim 1 above. Navarro also does not teach all of the limitations of new Claim 78. For example, Navarro does not teach, among other limitations, "introducing a catheter having a working end into the hollow anatomical structure, the catheter having a therapeutic energy device at the working end, the therapeutic energy device distinct from the light." Navarro teaches that any light emitted for positioning purposes (see Navarro Col. 5:1-6) is emitted through the very same optical fiber tip (tip 41) that is used for delivery of therapeutic energy. In fact, Navarro goes so far as to teach that "visible spectrum energy" "may be emitted concurrently with energy in other wavelengths." Navarro also teaches using a "traditional ultrasound imager" (Navarro Col. 5:5-6), which is a sound-wave device that is not introduced into the patient but instead emits energy from outside the body. Thus, the teachings of Navarro directly contradict the limitations of Claim 78. For at least these reasons, new Claim 78 is allowable over Navarro.

Although new Claim 89 recites different limitations than Claim 78, it is allowable over Navarro for similar reasons as those discussed above.

Navarro – Claim 50

In rejecting independent Claim 50, the Office Action implies that the Examiner believes Navarro teaches all of the claim limitations of Claim 50. However, the Office Action does not specifically indicate where these limitations are found in Navarro. For example, the Office Action never addresses the following portion of Claim 50: “introducing a guide wire having a hook-shaped tip into the hollow anatomical structure.” Nor does the Office Action discuss this portion of Claim 50: “hooking the hook-shaped tip of the guide wire to an ostium of a junction within the hollow anatomical structure.” Instead of addressing the language of the claim, the Office Action merely asserts:

The reference also teaches the step of introducing the catheter over a guide wire with a tip located at the distal end of the guide wire or located at the working end of the catheter wherein the guide wire transverses a lumen in the catheter and the tip is adaptable to engage the junction of the anatomical structure while the catheter travels over the guide wire to the junction where it “wedges” against the junction (col. 4 lines 39-43). Office Action at p. 3.

It is difficult to determine if this passage from the Office Action is even referring to independent Claim 50, but even if this passage is an attempt to demonstrate that Claim 50 is anticipated, the attempt is not successful. For example, the passage does not even assert that the limitations referenced above are taught or suggested by Navarro. Indeed, these limitations are not taught or suggested by Navarro. The section of Navarro cited by the Examiner states, in its entirety:

As shown in FIGS. 3A and 3B, angiocatheter 38, or a device of similar function, is placed percutaneously into greater saphenous vein 30. To aid in the placement of catheter 38, ultrasound imaging, or a similar function device may be used. (Navarro Col. 4:39-43).

Applicants respectfully traverse the rejection of Claim 50, at least because Navarro does not teach, at this cited section or elsewhere, “hooking the hook-shaped tip of the guide wire to an ostium of a junction within the hollow anatomical structure” as recited in Claim 50. In fact, as one can see from above, the cited section of Navarro recommends that a different method—namely, an ultrasound imager—be used to aid in the placement of the angiocatheter.

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Additionally, it is unknown where support is derived for the statements in the Office Action such as: “the tip [of the guide wire] is adjustable”; or “the catheter travels over the guide wire to the junction where it ‘wedges’ against the junction.” Neither of these statements is supported by the cited section of Navarro, and neither appears to be drawn from any other passage of Navarro. However, even if these statements were drawn from a reference, they would not be sufficient to support a 35 U.S.C. §102(e) rejection of Claim 50 because they do not correspond to the limitations of Claim 50. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See also* M.P.E.P. 2131.

Lastly, the Examiner at page 3 of the Office Action places the word “wedges” in quotes, implying that either Navarro uses the term “wedges” in its disclosure, or that the term “wedges” is a claim limitation. Neither proposition is true. A search of the Navarro et al. disclosure confirms that the word “wedges” is not used therein. Nor does the cited section disclose a method that would involve “wedging” or something similar thereto. The claims of above-referenced application likewise do not recite a “wedge” or “wedging.”

For at least the reasons discussed above, the Navarro et al. reference does not disclose or suggest limitations of Claim 50, and it is respectfully requested that the rejection be withdrawn.

Dependent Claims

The rejection of claims 12-15 and 39 in view of Navarro and in combination of Makower et al. has been rendered moot by the cancelling of those claims.

Numerous dependent claims remain pending but rejected over the prior art. Applicants respectfully submit that the pending dependent claims are also in condition for allowance for at least the reason that they depend from allowable based claims, as well as their recitation of further novel and non-obvious features and/or combinations of features.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

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Applicants respectfully do not concede the correctness of the Examiner's rejections or of the Examiner's assertions regarding what the prior art shows or teaches. Although the present communication may include alterations to the claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including any subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child, or related prosecution history should not infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application. Moreover, any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

Co-Pending Applications of Assignee

Applicant wishes to draw the Examiner's attention to the following co-pending applications of the present application's assignee.

Serial Number	Title	Filed
11/491065	THERMAL THERAPEUTIC CATHETER WITH LOCATION DETECTION ENHANCEMENT	July 21, 2006
11/732771	PHLEBECTOMY ILLUMINATION DEVICE AND METHODS	April 4, 2007

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Andrew M. Douglas, at (949) 760-0404 to resolve such issue(s) promptly.

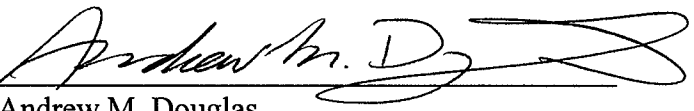
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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